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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,181	02/20/2002	Mark D. Summers	42390P13860	7337

8791 7590 03/04/2003

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EXAMINER

TOLIN, GERALD P

ART UNIT PAPER NUMBER

2835

DATE MAILED: 03/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/079,181	Applicant(s) SUMMERS ET AL.	
	Examiner Gerald P Tolin	Art Unit 2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 27-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,8-13,15-19,22,25 and 26 is/are rejected.
- 7) ☒ Claim(s) 3,4,6,7,14,20,21,23,24 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                  | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other:  |

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-26, drawn to a cooled electronic article, classified in class 361, subclass 719.
- II. Claims 27-30, drawn to a method of making the article, classified in class 29, subclass 832+.

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case steps such as attaching and coupling are so broad as to be capable of producing a multitude of different articles.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mr. Travis on 2-27-03 a provisional election was made without traverse to prosecute the invention of group I, claims 1-26.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 27-30 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

5. The IDS references are made of record.

6. The drawings are objected to. Figure 3 actually has two figures. 3A and 3B might be employed.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5,15-18,22,25 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 and 22 which refer to a standard, which can be changed over time, depend on a variable and are therefore indefinite. Also, variations within the standard are possible.

The claim 15/25 opening is confusing. It is not clearly stated in what member such is located. Please correct the claim language and explain by reference to the drawings.

The claim 17 "optimized" is totally unclear as to precise structure and is therefore indefinite. The claim 18 opening is noted. Where is such seen in the drawings?

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1,2,5,8-12,15 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by either Prasanna (1449 art) or French 2803166(see usPGpub 2002/0172010 of the same family cited herein).

Concerning Prasanna, such is explained first.

See figures 5 and 6. Board 18 with components, top and bottom sinks 14/16, thermal pads 52 and coupling member 66/68(a member in the final article) are shown. All other claimed elements are clearly present.

The French reference has a similar structure with elements 9 being the thermal coupling member. All else is clearly seen.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Prasanna or the French reference 2803166 .

Attachment of the parts by screws/etc., while not shown by the references, is old and well known and would have been obvious to employ to attach the parts together.

13. Claims 3,4,6,7,14,16,18,20,21 and 23-26 are not rejected on art and are therefore objected to (except for claims 16,18,25 and 26 which have 112 rejections).

14. Claims 19 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Prasanna or French 2803166 taken with the given "Draft Standard---Mezzanine" publication( 1449 art).

Prasanna and the French reference show most details as explained in the previous paragraphs. The given publication such as on page 4 provides the carrier/mezzanine environment. It would have been obvious to one of ordinary skill in the art to obtain the

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claimed details by using the Prasanna or French cartridge in the Publication teachings.

Similar fields renders such references compatible.

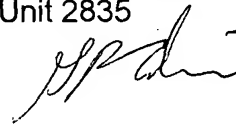
15. The non-elected claims should be cancelled.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald P Tolin whose telephone number is 703-308-3114. The examiner can normally be reached on M-F first friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Leo Picard can be reached on 703-308-0538. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-1341 for regular communications and 703-305-1341 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

Gerald P Tolin  
Primary Examiner  
Art Unit 2835



gpt  
February 28, 2003